

REMARKS/ARGUMENTS

The August 24, 2005 Office Action asserts that the reply filed June 9, 2005 is not fully responsive to the March 9, 2005 Office Action, because Applicants argue with respect to Claims 5-8, that the combination of D-Andrea (U.S. Patent 5,395,366) and Sanderford (U.S. Patent 4,799,062) does not teach having an *in vivo* radio device that includes the position measuring unit as claimed. In particular, the August 24, 2005 Office Action asserts that with respect to Claims 6-8, the Examiner's rejection specifically addressed Claims 6 and 8, and why it would have been obvious to modify the references, although the rejection did not state that the references taught the claimed features. Moreover, the Office Action asserts that Applicants' response only states that the references do not teach the claimed subject matter and fails to discuss the obviousness of the *in vivo* measuring unit as stated in the rejection.

In reply, Applicants renew their assertion that neither D-Andrea nor Sanderford disclose the feature as claimed in Claim 6, namely an *in vivo* radio device having a position measuring unit The Office Action of March 9, 2005 explains that it "would have been an obvious matter of design choice to a person of ordinary skill in the art to have the *in vivo* device be able to receive a position measuring signal from an *ex vivo* device . . .". The Office Action further states that "it is well known in the art that implanted device be able to receive signals, transmit signals or both in order to better communicate with devices outside the body". Finally, the Office Action asserts that "therefore to locate the means for measuring the position of the *in vivo* device either outside the body or inside the body would have been obvious to one skilled in the art at the time the invention was made".

Applicants maintain their traversal of this rejection. The MPEP §2142 explains that to create a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim limitations, and these teachings or

suggestions must both be found in the prior art and not based on Applicants disclosure. (In re Vaech, 947 f.2d 488 20 USPQ 2d 1438 (Fed. Cir. 1991). It is respectfully submitted that despite the Office's assertion that it would have been a matter of design choice or well known in the art, nevertheless the Office has not met its burden of establishing a *prima facie* case of obviousness because neither of the asserted references actually disclose, teach or suggest the claimed feature.

Furthermore, MPEP §2144.03 makes clear that a rejection based on "common knowledge" should be used judicially. MPEP §2144.03(a) explains that official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. It is respectfully submitted that that is not the case here, and therefore it is believed improper for the outstanding Office Action to reply on a feature that is absent in the claim as being "well-known", when neither reference teaches or suggests this feature, and no documentary evidence has been provided to support the Office Action's assertion. MPEP §2144.03(b) explains that ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. It is respectfully submitted that that burden has not been met by the Office. Accordingly, it is respectfully submitted that the Response filed on June 9, 2005 is proper and Applicants request an action on the merits in view of Applicants having identified that the Office Action

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failed to create a *prima facie* case of obviousness to Claims 6 and 8, and no documentary evidence has been provided to support an assertion that the claimed features are "well known" in the art.


Respectfully submitted,

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